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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,953	05/04/2005	Hiroshi Kawato	271725US0PCT	9608
22850	7590	01/28/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MCCLENDON, SANZA L	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			01/28/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/533,953	Applicant(s) KAWATO ET AL.	
	Examiner Sanza L. McClendon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/08/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on 12/08/2008, the examiner has carefully considered the amendments. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claims 1-3 and 5-13 have been overcome by the amendment and has hereby been withdrawn for consideration.

Response to Arguments

2. Applicant's arguments with respect to claims 1-3 and 5-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102***Claim Rejections - 35 USC § 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).\

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 6-13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takagi et al (6,956,073).

Takagi et al sets forth a composition comprising A) an aromatic polycarbonate resin from 50-100% by weight and a styrene containing resin from 0 to 50% by weight; B) a flame retardant having a phosphoric-ester group; C) a titanium dioxide pigment, D) an inorganic filler, F) a fluorine-containing compound and other additives. The titanium dioxide pigment can be found in amounts from 0.5 to 10 parts by weight. The titanium dioxide is preferably surface treated with an inorganic surface treating agent, such as aluminum oxide or others, such as silicon, titanium, zirconium, antimony, zinc or tin—see column 23, lines 10-15. Takagi et al sets forth coated titanium dioxide has a TiO₂ content of 89-98% and an inorganic coating of aluminum oxide from 0.5 to 4.5%, for example—see column 22, lines 43-55. In the method of making said coated TiO₂, Takagi et al is coated, neutralized, by-products removed and washed in pure water, dried and then milled—see columns 22, lines 60 to column 23, line 3. Additionally, Takagi et al teaches said inorganic coated TiO₂ can be further surface treated with organic surface-agents, such as alkoxysilanes, amines and polyols—see column 23, lines 30-55. Said organic surface treatment can be added in amounts of 1% by weight based on 100% by weight of the inorganic surface coated titanium oxide. Other components in the composition can include breaking inhibitors for the inorganic filler, such as polyorganosiloxanes—see column 25, lines 5-10. Other additives (E) include mold release agents, such as organosiloxanes—see column 29, line 25. Takagi et al sets forth said compositions can be used to make molded articles via

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injection molding processes--see column 33, lines 5-18. Per example 12, in Table 1, Takagi et al teaches using aluminum coated titanium particle under the tradename TIPAQUE PC-3 as well as others. It is deemed that these, along with the teachings found in the disclosure regarding the TiO₂ content and the surface coating content (see column 22, lines 43-55) should inherently have the same extractable content as claimed when washed in water since these meet the definition for the TiO₂ as claimed.

In the alternative, Takagi et al does not expressly teach that said coated particles have extractable cations in amounts from 120 mass ppm or lower, such as found in claims 1, 3, 6, 10 or 11. However, per example 12, in Table 1, Takagi et al teaches using aluminum coated titanium particle under the tradename TIPAQUE PC-3, as well as, others. And since the Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether Applicant's composition differs and, if so, to what extent, from the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-obviousness by objective evidence is shifted to the Applicants.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al (as cited above).

8. Takagi et al does not expressly teach the addition of 0.05 to 3 parts by weight of an organopolysiloxane blended in 100 parts by weight of the thermoplastic resin.

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However, Takagi et al teaches the addition of a mold release agent that can be an organopolysiloxane compound—see column 29, line 25. And per examples 21-22 in Table 3, Takagi et al teaches adding 0.1% of a mold release agent. Therefore the examiner deems that it would have been within the skill of an ordinarily skilled artisan to add at least 0.1% of a polyorganosiloxane mold release agent as taught by Takagi et al. The motivation would have been a reasonable expectation adequate mold release of the cured composition as taught by the reference in the absence of evidence to the contrary and/or unexpected results.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sanza L McClendon/

Primary Examiner, Art Unit 1796

SMc

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